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23 UNITED STATES DISTRICT COURT
24 NORTHERN DISTRICT OF CALIFORNIA
25 OAKLAND DIVISION

26 INTERTRUST TECHNOLOGIES
27 CORPORATION, a Delaware corporation,

28 Plaintiff,

v.

MICROSOFT CORPORATION, a
Washington corporation,

Defendant.

AND RELATED CROSS-ACTION.

CASE NO. C01-1640 SBA (MEJ)

Consolidated with C 02-0647 SBA (MEJ)

**MICROSOFT'S NOTICE OF MOTION
AND MEMORANDUM IN SUPPORT
OF MOTION FOR PARTIAL
SUMMARY JUDGMENT OF
INVALIDITY OF THE ASSERTED
CLAIMS OF THE '900 PATENT
(ANTICIPATION)**

Date: March 30, 2004
Time: 1:00 p.m.
Judge: Sandra B. Armstrong

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1 appropriate in a patent case as in any other.” See *Avia Group International, Inc. v. L.A. Gear*
2 *California, Inc.*, 853 F.2d 1557, 1561 (Fed. Cir. 1988); *Spectra Corp. v. Lutz*, 839 F.2d 1579,
3 1581 n. 6, (Fed. Cir. 1988); *Brenner v. United States*, 773 F.2d 306, 307 (Fed. Cir. 1985).
4 “Where no genuine issue of material fact remains and the movant is entitled to judgment as a
5 matter of law, the court should utilize the salutary procedure of Fed. R. Civ. P. 56 to avoid
6 unnecessary expense to the parties and wasteful utilization of the jury process and judicial
7 resources.” *Barmag Barmer Maschinenfabrik AG v. Murata Machinery, Ltd.*, 731 F.2d 831, 835
8 (Fed. Cir. 1984); *Brassica Protection Products LLC v. Sunrise Farms (In re Cruciferous Sprout*
9 *Litig.*, 301 F.3d 1343, 1346 (Fed. Cir. 2002) (“Summary judgment is appropriate when there is no
10 genuine issue of material fact and the moving party is entitled to judgment as a matter of law.”).

11 Summary judgment is warranted when the moving party has demonstrated that
12 there is no genuine issue as to any material fact and the moving party is entitled to a judgment as
13 a matter of law. See Fed. R. Civ. P. 56(c). A fact is material if it

14 “might affect the outcome of the suit under the governing law.”
15 *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). “With
16 respect to whether there is a genuine issue, the court may not
17 simply accept a party’s statement that a fact is challenged.
18 (Citations omitted). The party opposing the motion must point to
an evidentiary conflict created on the record at least by a counter
statement of a fact or facts set forth in detail in an affidavit by a
knowledgeable affiant. Mere denials or conclusory statements are
insufficient.”

19 *Barmag*, 731 F.2d at 835-36.

20 **B. Legal Standard For Patent Invalidity**

21 **1. Requirements of 35 U.S.C. § 102(b)**

22 A party challenging the validity of a patent claim has the burden of showing
23 invalidity by clear and convincing evidence. *Brassica*, 301 F.3d 1343, 1349 (Fed. Cir. 2002).
24 Microsoft moves for summary judgment of invalidity based on 35 U.S.C. § 102(b), which states
25 that an individual is not entitled to a patent if their claimed invention “was patented or described
26 in a printed publication in this or a foreign country ... more than one year prior to the date of the
27 application for patent in the United States.” 35 U.S.C. § 102(b). Summary judgment should be
28 granted where the defendant demonstrates that each element of the challenged claim is disclosed

1 in a single prior art reference. *See id.*; *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001).

2 The Durst Patent was filed on June 3, 1988 and issued on May 12, 1992.
3 InterTrust claims a priority date of August 12, 1996 for the '900 Patent. The Durst Patent issued
4 more than four years before the purported effective filing date of the '900 Patent and thus
5 indisputably is prior art to the '900 Patent. Also, as will be shown below, its specification
6 discloses all elements of claims 155, 156 and 157 of the '900 Patent. The Durst reference is
7 therefore invalidating prior art under 35 U.S.C. § 102(b), as the purported invention of claims
8 155-157 "was ... described in a printed publication in this ... country ... more than one year prior
9 to the date of the application for patent in the United States" for the '900 Patent.

10 **2. Presumption of Enablement**

11 In addition to preceding the challenged patent claims by more than one year and
12 disclosing all of the claim elements, an anticipatory reference must enable one of skill in the art to
13 reduce the disclosed invention to practice. *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d
14 1313, 1354 (Fed. Cir. 2003). As an issued U.S. patent, the Durst reference carries a presumption
15 that it is enabling, even as to the unclaimed material in its disclosure. *Id.* at 1355 ("We hold that
16 an accused infringer should be ... entitled to have the district court presume the enablement of
17 unclaimed (and claimed) material in a prior art patent defendant asserts against a plaintiff"). It is
18 InterTrust's burden to overcome the presumption of enablement by bringing forward evidence of
19 non-enablement. *Id.*

20 **III. ARGUMENT**

21 **A. Overview of the Challenged Claims and the Durst Patent**

22 **1. Claims 155, 156 and 157 of the '900 Patent**

23 Claims 155, 156 and 157 of the '900 Patent each claim the same device, differing
24 from each other only with regard to the final element:

	Claim Language
	A virtual distribution environment comprising a first host processing environment comprising
(hardware)	a central processing unit; main memory operatively connected to said central processing unit;

1		mass storage operatively connected to said central processing unit and
2		said main memory;
3		said mass storage storing tamper resistant software designed to be loaded
4	(software)	into said main memory and executed by said central processing unit,
5		said tamper resistant software comprising:
6		machine check programming which derives information from one or
7		more aspects of said host processing environment,
8		one or more storage locations storing said information;
9		integrity programming which causes said machine check programming to
10	Claim 155	derive said information, compares said information to information
11	Claim 156	previously stored in said one or more storage locations, and
12		generates an indication based on the result of said comparison; and
13	Claim 157	programming which takes one or more actions based on the state of said
		indication;
		said one or more actions including ...
		... at least temporarily halting further
		processing.
		... at least temporarily disabling
		certain functions.
		... displaying a message to the user.

The claimed device consists of a virtual distribution environment ("VDE") made up of a host processing environment ("HPE") comprising standard personal computer hardware – a central processing unit ("CPU"), main memory (e.g., RAM) and mass storage (e.g., disk drive) – operationally connected to each other so that each can perform its familiar function. The mass storage stores software capable of being loaded into main memory and executed by the CPU.

The claimed software has three aspects: (i) machine check programming, which derives information from one or more aspects of the HPE and stores it in one more storage locations; (ii) integrity programming, which activates the machine check programming to derive the same information and compares it to the information previously stored, and (iii) programming that takes one or more actions depending on the result of the comparison. As will be shown below, the claim elements make out a programming structure that the Durst reference disclosed more than four years before the '900 Patent application was filed.

Before engaging in an element-by-element comparison, it is useful to look at the claims as a whole. The specification of the '900 Patent provides context and sheds light on the purpose and function of the claimed purported invention. Programming that derives information

1 about a system; compares it to previously stored, similar information, and takes protective action
2 based on that comparison is well-known in the art – the derived, stored information is often called
3 a “machine signature.” The ’900 specification contains a discussion of machine signatures that
4 discloses program features corresponding to those of claims 155-57.

5 The disclosed “machine signature” technique involves two programming modules:
6 the “installation materials” and the “operational materials”:

7 The installation materials 3470 may be executed by computer 3372 to
8 install the operational materials 3472 onto the computer’s hard disk
9 3376. The computer 3372 may then execute the operational materials
10 3472 from its hard disk 3376 to provide software-based protected
processing environment 650 and associated software-based tamper
resistant barrier 672.

11 ’900 Patent, 231:25-31.

12 The installation materials derive a machine signature from the electronic appliance
13 and embed that signature into the operational materials. Then, when the operational materials are
14 initialized on an appliance, they derive the machine signature of the appliance and compare it to
15 the embedded signature:

16 Correspondence Between Installed Software and Appliance
17 “Signature”.

18 Another technique that may be used during the installation routine
19 3470 is to customize the operational materials 3472 by embedding a
20 “machine signature” into the operational materials to establish a
21 correspondence between the installed software on a particular
electronic appliance 600 (FIG. 69C, block 3470(7)). This technique
prevents a software-based PPE 650 from being transferred from one
electronic appliance 600 to another (except through the use of the
appropriate secure, verified backup mechanism).-

22 For electronic appliances 600 where it is feasible to do so, the
23 installation procedure 3470 may determine unique information about
24 the electronic appliance 600 (e.g., a “signature” SIG in the sense of a
unique value--not necessarily a “digital signature” in the cryptographic
25 sense). Installation routine 3470 embeds the electronic appliance
“signature” SIG in the installed operational materials 3472. Upon
26 initialization, the operational materials 3472 validate the embedded
signature value against the actual electronic appliance 600 signature
SIG, and may refuse to start if the comparison fails.

27 ’900 Patent, 239:4-25. This language is followed by a description of how various machine
28 parameters can be used to generate signatures. *Id.*, 239:26-240:42. To summarize, the

1 installation programming embeds a machine signature in the “PPE” (“Protected Processing
2 Environment”) software, which embedded signature is validated each time the PPE is initialized
3 by comparing it to the machine signature of the current machine. If the two signatures do not
4 match, reflecting that the PPE software has been transferred to a different, unauthorized machine,
5 the PPE refuses to start.

6 2. The Durst Reference – Overview

7 The Durst Patent, titled “Method and System for Preventing Unauthorized Use of
8 Software,” discloses the same arrangement, functioning in the same manner, with the same
9 elements. The Durst system also has the same purpose as the claimed ’900 Patent’s system – to
10 prevent the use of software on an unauthorized computer. The abstract of the Durst Patent
11 succinctly captures its close similarity to the apparatus in claims 155-157 of the ’900 Patent:

12 A technique is disclosed for preventing a computer program from
13 being used by a computer system other than a designated system. The
14 values of certain characteristics exhibited by the designated computer
15 system first are stored, and then the values of those same
16 characteristics exhibited by the computer system which is intended to
17 use the computer program are measured and compared to the stored
values. If the compared values are substantially the same, the
computer program may be executed. However, if they are different,
the computer system which was intended to use the program is
inhibited from executing that program.

18 And, just as in the ’900 Patent, Durst discloses embedding the machine signature in the software
19 itself. Durst, 26:14-21; 27:11-13. The sections that follow show in detail that Durst discloses
20 each and every element of these three ’900 Patent claims.

21 3. The System Environment

22 The three ’900 Patent claims first recite the computing context in which the
23 programming operates. These basic elements are as follows:

24 Claim 25 Language	A virtual distribution environment comprising
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26 As construed by the Court, this element is simply the sum of the other elements
27 that follow. A “virtual distribution environment” is “defined by the elements of 900.155 [claim
28 155 of the ’900 Patent]; it has no definition independent of those elements.” Order Denying

1 Motion for Partial Summary Judgment and Construing “Mini-Markman Claims” (“Markman
2 Order”), July 3, 2003, at 55.¹ Therefore, the Durst reference need not disclose it as such.²

3 Claim 4 Language	a first host processing environment comprising
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5 The Court has defined “host processing environment” (“HPE”) to mean
6 “capabilities available to a program running on a computer or other device or to the user of a
7 computer or other device,” which, “[d]epending on the context ... may be in a single device (*e.g.*,
8 a personal computer) or may be spread among multiple devices (*e.g.*, a network).” Markman
9 Order, at 45. There is a further distinction between a non-secure HPE and a secure HPE, the
10 latter having two additional features: its “processing and/or data is at least in part protected from
11 tampering,” and it incorporates “software-based security.” *Id.*

12 The Durst reference discloses “HPEs” of both types. First, the Durst reference
13 discloses that its technology is to be used within a computer system. Durst, Fig. 1, and 5:60-64.
14 Second, the software is “tamper-resistant” (“make[s] tampering more difficult and/or allow[s]
15 detection of tampering,” Markman Order, at 51). Durst discloses an embodiment in which the
16 machine signature is itself stored within the software in encrypted form and can thereafter be
17 altered only with a password provided by the manufacturer. In this embodiment, the
18 manufacturer will first confirm that the customer has modified the system hardware and is
19 authorized to receive a new password. Durst, 26:14-21; 27:11-13; 28:6-27. Additionally, the
20 software may be programmed to change the encrypted key after re-recording the machine
21 signature so that each password may be used only once. Durst, 28:3-27. The encryption makes it
22 more difficult to tamper with the machine signature, which is both part of the software’s code and
23 central to its authorization functions.

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25 ¹ The same would presumably apply to the VDE element of claims 156 and 157, which employ
26 the term “VDE” in exactly the same fashion as claim 155 and which are otherwise almost
identical to claim 155.

27 ² Microsoft maintains its argument that “VDE” is the “present invention” identified in the ‘900
28 Patent (‘900 Patent, 2:19-32), and that the asserted claims are invalid for lack of written
description (35 U.S.C. § 112), non-enablement and are not infringed.

1 Finally, the system described in Durst incorporates “software-based security.” The
2 Court has construed “secure” to mean employing “[o]ne or more mechanisms ... that prevent or
3 discourage ... misuse of or interference with information or processes for the purpose of
4 discouraging and/or avoiding harm,” which mechanisms may include “tamper resistance” and
5 “authentication,” the latter separately defined to mean “[i]dentifying (e.g. a ... device ...
6 includ[ing] uniquely identifying.” The software contains both the encryption tamper-resistance
7 feature described above, and authentication – programming that creates and uses machine
8 signatures to uniquely identify hardware and thereby prevent unauthorized use of the software.
9 Inasmuch as both of these forms of security are software-based, the Durst reference discloses all
10 the features of a HPE under either definition of that term.

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Claim	a central processing unit
Language	

12
13 A central processing unit is a standard computer component –in personal
14 computers, this is typically a microprocessor. The Durst Patent discloses a central processing
15 unit. Durst, Fig. 1; 7:26.

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Claim	main memory operatively connected to said central processing unit
Language	

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18 The Durst reference discloses a main memory (RAM) connected to the CPU.
19 Durst, Fig. 1; 7:18-20.

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Claim	mass storage operatively connected to said central processing unit and said
Language	main memory

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22 The Durst reference discloses mass storage (disk drive) connected to the CPU and
23 main memory. Durst, Fig. 1; 8:15-18 (“... for convenience, the following description is directed
24 to software embodied in the form of a floppy disk, although the specification should be
25 interpreted to include ... other mass storage devices”); 9:3-4 (“Disk drive 116 may take the form
26 of a floppy disk drive or a fixed disk drive, the latter also being referred to as a ‘hard’ or
27 ‘Winchester’ disk drive”).
28

1 2	Claim Language	said mass storage storing tamper resistant software designed to be loaded into said main memory and executed by said central processing unit, said tamper resistant software comprising
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3 The Durst software is tamper resistant (see discussion of HPE claim element,
4 above). It is, in the standard fashion, loaded from mass storage (e.g., a hard or floppy disk drive)
5 into main memory (e.g., RAM) and executed by the CPU.

6 4. **The Programming Is The Same**

7 The “programming” in the claims at issue has three aspects: “machine check
8 programming,” which undertakes the generation and storage of the machine signature based on
9 HPE information; “integrity programming,” which activates the machine check programming to
10 re-generate the machine signature and compares the result with the stored signature; and
11 “programming which takes one or more actions” based on the result of the comparison. The
12 Durst Patent discloses all of these.

13 a. **Machine Check Programming**

14 15	Claim Language	machine check programming which derives information from one or more aspects of said host processing environment, one or more storage locations storing said information
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16 (1) **The Meaning of This Element**

17 “Machine check programming” is a module that derives information from one or
18 more aspects of the HPE. The court has defined “derive” to mean “obtain, receive, or arrive at
19 through a process of reasoning or deduction. In the context of computer operations, the ‘process
20 of reasoning or deduction’ constitutes operations carried out by the computer.” Markman Order,
21 at 21. In other words, the computer programming carries out operations on aspects of the
22 computing environment to produce data in some form (the machine signature), which it then
23 stores.

24 The parties agree that this claim language applies to any derivation of information
25 that represents an attribute of the hardware on which the machine-check programming is running.
26 Throughout its infringement chart, for instance, InterTrust matches this language with the

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1 following description of an infringing element: "derives from the client computer . . . hardware ID
2 information." InterTrust's Amended Disclosures of Asserted Claims and Preliminary
3 Infringement Contentions ("IT's Amended Disclosures"), at 18, 20, 34, 36, 38, 40, 42, 44
4 (emphasis added). In short, the machine signature may be based on hardware information.

5 The parties also agree that hardware ID information can be based on any parameter
6 of the physical, material part of the computer, such as "one or more of the CDROM device, disk
7 adapter, disk device, display adapter, first drive serial number, MAC address, processor serial,
8 processor type, RAM size, SCSI adapter, PCMCIA controller, audio adapter, and whether the
9 computer is dockable." IT's Amended Disclosures, at 25. Elsewhere in its chart, InterTrust lists
10 an overlapping but somewhat different set of hardware attributes that could serve as the source of
11 the derived information. Microsoft agrees that any hardware parameters will do.

12 "Machine check programming" *cannot*, however, refer to the derivation of
13 attributes solely from software files stored on the system. InterTrust has taken inconsistent
14 positions on this point, arguing that even a software module that derives its checkable values
15 entirely from such files can constitute "machine check programming." *See, e.g.*, IT's Amended
16 Disclosure, at 23 (accusing Windows File Protection). InterTrust's inconsistency is immaterial to
17 this motion as Durst clearly teaches deriving information from hardware, which satisfies the
18 requirements of § 102(b) anticipation.

19 (2) Machine Check Programming in the Durst Reference

20 The Durst Patent discloses machine-check programming that generates a machine
21 signature from hardware parameters and stores it. The software contains a "measure signature"
22 step, Durst, Fig. 14 (and see generally 26:55-27:31), and "the 'signature' of a computer system is
23 intended to refer to the values of certain characteristics exhibited by that system." Durst, 3:45-47.
24 The characteristics can be of two types: "(a) parameters which are designed specifically into
25 individual computer systems (such as the type of processor, the version of operating software,
26 etc.), and (b) parameters which are defined by particular tolerances in the manufacture of the
27 computer system and its peripherals (e.g., the specific rotating speed of a disk drive, which may

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1 vary within a range of design tolerances, etc.).” *Id.*, 3:60-68. Much of Durst’s written description
2 explains how to measure particular hardware characteristics in order to create a machine
3 signature, such as the

4 identification of the computer system processor, the clock speed of
5 the computer system clock generator, an identification of the
6 computer system ROM, the wait time, or wait cycles, assigned to
7 the computer system processor for accessing a RAM, the rotary
8 speed of a computer system disk drive, the access speed of that disk
9 drive and the sector interleave value of that disk drive.

10 *Id.*, 3:50-57; col. 11 – col. 25 (detailed description of measuring techniques). However, “[t]he
11 invention is not intended to be limited solely to these examples; and other characteristics which
12 can be used to distinguish one computer system from another are contemplated.” *Id.*, 3:57-60.
13 The signature is “determined in accordance with the subroutines” that extract these various
14 hardware measurements, as described in columns 11-25. Durst, 25:58-60.

15 The Durst reference also discloses “one or more storage locations storing said
16 information”: “After the signature of the computer system has been measured, it is recorded, or
17 stored, in the software integrated with the applications program.” *Id.*, 26:14-16; also 27:11-13.

18 **b. Integrity Programming**

19 Claim Language	integrity programming which causes said machine check programming to derive said information compares said information to information previously stored in said one or more storage locations, and generates an indication based on the result of said comparison
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20 **(1) The Meaning of This Element**

21 The integrity programming activates the machine check programming, causing it
22 to derive information based on HPE parameters in the same manner as discussed above, to
23 compare the result to the previously stored result, and to generate an indication reflecting the
24 outcome of that comparison.

25 An aside is needed regarding the phrase “said information.” This language is
26 slightly confusing in that it might be taken to mean that the *results* of the derivation of
27 information must be the same as the previously stored information. Yet the purported invention’s
28 functionality depends on comparing the latter result with the machine signature previously stored

1 to determine if the two are different. Thus, "said information" must mean information derived in
2 the same manner by the same programming, but which may lead to a different value each time it
3 is run. This construction of the term is supported by the specification, '900 Patent, 239:4-25, and
4 by InterTrust's own infringement chart.³ IT's Amended Disclosures, at 28.

5 (2) Integrity Programming in the Durst Reference

6 Just as in the '900 Patent claims, the Durst reference discloses programming which
7 causes the machine signature to be derived, compares it with the stored signature, and produces
8 an indication based on the result. On this point, the language of the Durst Patent is such that a
9 comparison chart is the most efficient way to demonstrate the correspondence between the claim
10 language and the Durst reference:

11 integrity programming 12 which	"The copy protection procedure inquires initially at 1402 if a signature has been stored previously on the floppy disk. If this inquiry is answered in the affirmative," (26:59-62; Fig. 14)
14 causes said machine 15 check programming to derive said information,	"then the signature of the computer system with which the applications program is intended to be run is measured." (26:62-64)
16 compares said 17 information to information previously 18 stored in said one or more storage locations, and	"If the measured signature is the same as the previously determined and stored signature, inquiry 1412 is answered in the affirmative and the applications program is executed, as represented by instruction 1408. However, if inquiry 1412 is answered in the negative, an error message is displayed, thereby indicating that an attempt has been made to run the applications program on an unauthorized computer system." (26:64-27:3)
19 generates an indication 20 based on the result of said comparison; and	

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27 ³ Microsoft rejects InterTrust's infringement assertions as to its products and cites InterTrust's
28 infringement position only to show that the parties are in agreement on the relationship between
the two different hardware checks that the software performs.

c. Programming That Undertakes an Action Based on the Comparison Result

Claim Language	programming which takes one or more actions based on the state of said indication
<i>Claim 155 only</i>	<i>said one or more actions including at least temporarily halting further processing.</i>
<i>Claim 156 only</i>	<i>said one or more actions including at least temporarily disabling certain functions.</i>
<i>Claim 157 only</i>	<i>said one or more actions including displaying a message to the user.</i>

The action the software takes upon discovering a discrepancy between the previous and the current machine signature is the only respect in which claims 155, 156 and 157 differ from one another. The Durst reference discloses a response to an attempt at unauthorized use of the software that satisfies each of these three different claim elements:⁴ “[I]f inquiry 1412 [the check of whether the present and stored signatures match] is answered in the negative, an error message is displayed, thereby indicating that an attempt has been made to run the applications program on an unauthorized computer system. It is appreciated that, under this condition, the applications program cannot be executed.” Durst, 26:68-27:5. This clearly meets the limitations of displaying a message to the user and disabling certain functions, respectively.

Regarding “at least temporarily halting processing,” the Durst Patent discloses that the consequence of a negative comparison of machine signatures is to halt processing of the protected software. Durst, Figs. 13B, 14, 15; col. 26:68-27:5.

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⁴ Microsoft notes that the claim language, read plainly, actually requires that the programming take one or more actions regardless of the outcome of the comparison: “programming *which takes* one or more actions based on the state of said comparison.”

1 **IV. CONCLUSION**

2 Because the Durst Patent disclosure has each and every element of the challenged
3 claims Microsoft respectfully requests that the Court declare claims 155, 156 and 157 of U.S.
4 Patent No. 5,892,900 to be invalid as anticipated by a prior patent, pursuant to 35 U.S.C.
5 § 102(b).

6 Dated: February 23, 2004

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